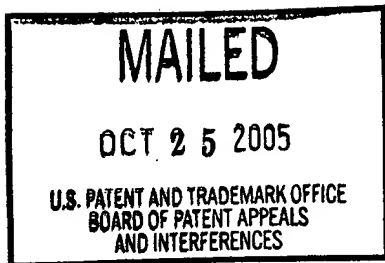


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PAUL C. ZIMMER



Appeal No. 2005-2375
Application No. 09/612,821

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a promotional calendar (claims 1-3) and a method of promoting an enterprise to selected individuals (claims 4 and 5). A copy of claims 2 to 5 is set forth in the appendix to the appellant's brief. Representative claim 1 reads as follows:

A promotional calendar comprising:
a series of pages each imprinted with a respective day of the year and held together to allow turning or tear off of each page;
each page prominently printed with the name of a person to personalize each page of the calendar;
each page also prominently printed with an identifier of an enterprise to be promoted, whereby said person's name and said enterprise identifier are visually associated on each page.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Hallam	964,967	July 19, 1910
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Claims 1 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hallam.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer

(mailed November 19, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed July 20, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In accordance with the appellant's grouping of claims section of the brief (p. 3), we have selected claim 1 as the representative claim from the appellant's grouping of claims 1 to 5 to decide the appeal on this rejection under 35 U.S.C. § 103.

In the rejection of claim 1 before us in this appeal (answer, p. 3), the examiner (1) found that Hallam teaches a promotional calendar comprising a series of pages each imprinted with a respective day of the year and held together to allow turning or tear off of each page, each page printed and distributed; (2) ascertained that Hallam does not teach each page prominently printed with the name of a person to personalize the calendar and an enterprise identifier; (3) determined that these differences are only

found in the non-functional descriptive material and thus, this descriptive material will not distinguish the claimed invention from the prior art in terms or patentability citing to In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The appellant argues (brief, pp. 3-5) that the examiner's reliance on Gulack and Lowry is misplaced. Specifically, the appellant points out that the promotional calendar claimed functionally relates the printed matter to the pages of a multi-page daily calendar. The heart of the concept of the appellant's invention is based on the powerful mental effect of recognition of one's own name. This recognition is used to promote an enterprise by the visual juxtaposition of a recipient's name and an enterprise identifier each day to create a mental association with the enterprise in the mind of the recipient. That is, a fresh impression of the mental association is presented to the recipient as he or she turns a page of the calendar and his or her attention is drawn anew that day to the appearance of his or her name in visual association with the enterprise identifier. In summary, the appellant asserts that the relation of such printed matter and a calendar is not suggested by Hallam and accordingly, not obvious under 35 U.S.C. § 103.

We agree with the examiner that Hallam discloses a calendar comprising a series of pages each imprinted with a respective day of the year and held together to

allow turning or tear off of each page and that the only differences between the instant invention and the Hallam calendar is the content of the printed matter placed on each page of the calendar.

Our reviewing court has stated that where the differences between the claimed invention and the prior art resides in printed matter, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); In re Gulack, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983)

In our view, there does not exist any new and unobvious functional relationship between the printed matter and the substrate. Therefore, we will sustain the rejection of the examiner.

While it may be true that the appellant's printed matter (i.e., the name of a person to personalize the calendar and an enterprise identifier) creates a mental association, the functional relationship between the printed matter and the pages of the calendar is the same functional relationship as depicted in Hallam. It is the functional relationship of the printed matter to the pages of the calendar which is critical in a determination of patentability of claim 1.

In view of the foregoing, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

In accordance with the appellant's grouping of claims, claims 2 to 5 falls with claim 1. Thus, it follows that the decision of the examiner to reject claims 2 to 5 under 35 U.S.C. § 103 is also affirmed.


CONCLUSION

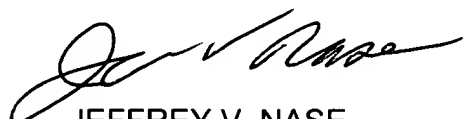
To summarize, the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2005-2375
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Page 8

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